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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/611,359 | 06/30/2003 | Kiyoshi Miyazaki | 50632/DBP/A400 | 8168 |
| 23363 | 7590 | 04/05/2004 | EXAMINER | |
| CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105 | | | | PARA, ANNETTE H |
| ART UNIT | | PAPER NUMBER | | |
| | | 1661 | | |

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--|-----------------|-----------------|
| | Application No. | Applicant(s) |
| | 10/611,359 | MIYAZAKI ET AL. |
| | Examiner | Art Unit |
| | Annette H. Para | 1661 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 June 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: 105 requirement.

DETAILED ACTION

Drawings

The drawings are objected to because they are not in compliance with the new rules.

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. Complete details can be found in the May 22, 2001 *Official Gazette* or on the internet at <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Information Disclosure Statement by Applicant

In the IDS filed on December 08 2003 applicant mentioned that the Japanese PBR was filed on October 3, 2003 and that it was published on March 25, 2002. It is unclear how a publication can be published before it is filed. The abstract of the Japanese PBR mentions that the application was filed on December 28, 2001. Applicant needs to correct these discrepancies. A substitute IDS form listing this publication should be filed in order for the publication to be considered by the examiner.

Objection to the Disclosure 37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

A. Page 2, lines 1, 2, 5, the recitation "Omi R & D Center, Suntory Flowers Ltd." should be deleted as such constitutes unwarranted advertising. Place of business can be cited only to point out the location where the observed plant has been discovered or asexually reproduced. MPEP 1610. Correction is required.

B. Applicant is requested to recite whether the parent cultivar 'Baccarat Red' has been patented in the United States, is currently the subject of pending U.S. plant patent application, or is unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name, or such could simply be acknowledged in applicant's next response.

C. On page 9, line 24 the word "Thin" does not describe a shape. Correction is required.

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- D. The disclosure is objected to under 37 CFR 1.163(a) because the specification does not particularly point out the location and character of the area where the plant was discovered and asexually reproduced. Correction is required.
- E. On page 2 the name of the color chart is misspelled as it should be "The Royal Horticultural Society Colour Chart". Correction is required.
- F. In the interest of providing as complete a botanical description as is reasonably possible applicants should set forth the description of petal size (length, width), shape, number, and margin. Correction is required.
- G. In the interest of providing as complete a botanical description as is reasonably possible applicants should set forth the description of petiole length, width, and diameter. Correction is required.
- H. In the interest of providing as complete a botanical description as is reasonably possible applicants should set forth the description of sepal size, shape, and margin. Correction is required.
- I. In the interest of providing as complete a botanical description as is reasonably possible applicants should set forth the description of peduncle size and texture. Correction is required.
- J. On page 3, line 27, page 5, line 8, page 6, line 20, page 7, line 30, and page 9, line 25 it is unclear what applicant meant by "shape of petal **chip**". Clarification is required.
- K. On page 3, line 29, page 5, line 10, page 6, line 22, page 7, line 32, and page 9, line 27 it is unclear what the applicant meant by "waving of petal". Clarification is required.

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L. On page 9, line 22, it is unclear what a “horizontal” facing direction” is? Clarification is required.

M. On page 9, lines 17-18 applicant should define what is the hardiness of the plant for cold and heat, and to which disease and pest the plant is resistant. Correction is required.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 USC § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

The claimed Petunia cultivar Sunpatire is described in Japanese Breeder's Right Application number 14306 that was published on March 25, 2002. The published application is a “printed publication” under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221,226,210 USPQ 790,794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through the Japanese Plant Breeders' Rights office. Plant varieties are also entered in the Plant Variety Protection Register, which is public.

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Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) (“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether ‘Siokra’ seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.”).

While the publication cited above disclose the claimed plant variety, a question remains as to whether the reference is enabling. If the plant was publicly available, then the application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office’s collection of retail catalogs have not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office’s collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has as attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

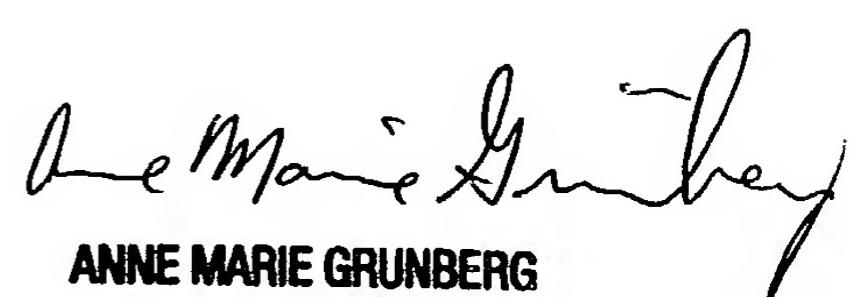
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Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The Examiner can normally be reached Monday through Thursday from 5:30 am to 4:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0994. The fax numbers for the group is (703) 872-9306. The Technology Center phone number is (571) 272-1600. Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

A.H.P



ANNE MARIE GRUNBERG
PRIMARY EXAMINER

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

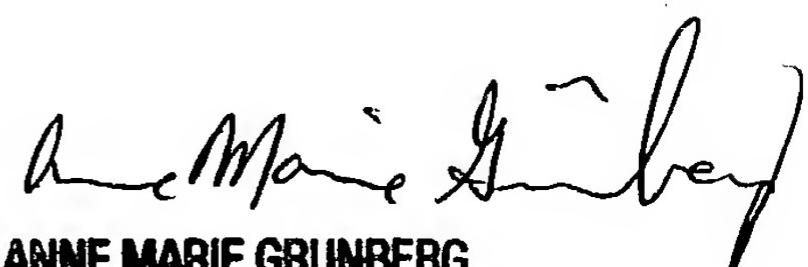
Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Sunpatire', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is as attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.



ANNE MARIE GRUNBERG
PRIMARY EXAMINER